

### **REMARKS**

Claims 1-9, 11-13 and 15-29, are currently pending in the application. Applicants note with appreciation the Office Action determination that claims 1-10 have allowable subject matter. By this amendment, claims 1-9, 11-13 and 15-24 are amended for form, claims 10 and 14 are cancelled, and new claims 25-29 are presented for the Examiner's consideration. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, each with an indication at its first line showing its current status.

The specification is amended for form by copying the recital beginning at page 7, line 30 and ending at page 8, line 4, and replicating that copy at page 12, beginning at line 19. The only change to the copied recital is the insertion of item number "9" after the phrase "contact pressure bars", to conform to the label of "9" on the depiction of the "contact pressure bars" in Applicants' Figs. 4 and 5. Applicants respectfully submit that this amendment for form does not add new matter because it does not add anything to the specification; it simply corrects a form issue in the translation of the German priority application.

#### **I. Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Office Action rejects the examined claims 1-10 on the stated grounds of "being incomplete for omitting essential steps, such omission amounting to a gap between the steps." Office Action at page 3. Applicants and Applicants' undersigned counsel have, in response, thoroughly reviewed all of the pending claims, and respectfully submit that the amended claims positively recite all "essential elements" in conformance with the guidelines set forth by MPEP § 2172.01. However, Applicants respectfully submit that the Office Action does not provide Applicants with the information required for Applicants to determine, with certainty, if this paper addresses and responds to all grounds of this "essential steps" rejection. Applicants therefore respectfully request that if the Examiner does not, for some reason, find the currently amended claims to conform with MPEP § 2172.01, that the Examiner contact the

undersigned to provide Applicants with a fair opportunity to respond, if necessary, before being limited by after-final procedures.

The Office Action rejects all of the examined claims on the stated grounds that they “appear to be a literal translation from a foreign document” and have “grammatical and idiomatic errors.” Office Action at page 3. Applicants respectfully respond that all of the amended and new claims have proper form and grammar.

The Office Action rejects the examined claim 1 under Section 112 on the stated grounds of:

- (i) “it is not clear what is encompassed by ‘the like’”;
- (ii) “[i]t is not clear what is meant by individual pieces of wood”;
- (iii) “there is lack of proper antecedent basis for ‘the leading group’ and ‘the following group.’

Office Action at page 2.

Applicants have amended claim 1 at line 2 to remove the phrase “the like,” and at line 6 to remove the phrase “individual pieces of wood.” Applicants have also amended claim 1 to clearly define “wood groups,” *see* claim 1 (currently amended) at lines 3-5, to remove the phrase “the following group,” *see id.* at line 16, and to provide proper antecedent basis for “the leading group.” *See id.* at lines 10-11, 17, 18 and 22-24.

The Office Action rejects all claims reciting the phrase “aforementioned.” *See* Office Action at page 2. Applicants have amended the claims to remove said phrase. *See* claim 2 (currently amended) at line 2 and line 5; *see also* claim 5 (currently amended) at line 2.

The Office Action rejects the examined claim 3 under Section 112, second paragraph, on the stated ground that “the phrase ‘preferable immediately before ... formed’ is vague and indefinite.” Office Action at page 3. Applicants have amended claim 3 to remove the identified phrase and to clearly recite the “moistening” limitations. *See* claim 3 (currently amended) at lines 2-5.

The Office Action rejects the examined claim 6 as indefinite on the stated grounds that it is “not clear” if the phrase “a plurality of line-forming groups” is “the same as ‘the group’ recited in line 2 of claim 1.” Office Action at page 3. Applicants have amended claim 6 to remove the identified phrase, and to clearly recite the conveying as applying a

first advancement and a second advancement force to different wood groups in the line, respectively, and that these force are different. *See* claim 6 (currently amended) at lines 2-6.

The Office Action rejects the examined claim 9 as indefinite on the stated ground that “it is not clear what is encompassed by line 4 of the claim.” Office Action at page 3. Applicants have amended claim 9 to recite “given thickness.” *See* claim 9 (currently amended) at lines 4 and 6. Applicants respectively submit that the subject matter encompassed by the “given thickness” limitation is clear within the meaning of 35 U.S.C. § 112, second paragraph.

Regarding claim 10, Applicants have cancelled this claim, rendering the rejection under Section 112 moot.

The Office Action rejects the examined claim 11 as indefinite under Section 112, second paragraph, on a plurality of stated grounds. *See* Office Action at page 3. Each will be addressed, in the order set forth in the Office Action. Regarding the phrase “for carrying out the process ... of the preceding claims,” Applicants have amended claim 11 to remove said phrase. *See* claim 11 (currently amended) at line 2. Regarding the “functional limitations recited in subpart c,” Applicants have amended claim 11 to positively define all structural limitations. *See* claim 11 (currently amended) at, *e.g.*, lines 6-9, 11-20, 22-23 and 24-28. Regarding antecedent basis for “the conveying element,” Applicants have amended the claim to reference the subject matter with language having proper antecedent basis. *See* claim 11 (currently amended) at lines 11, 14 and 19.

Regarding the rejection of claim 13 on the stated grounds that it “recites an improper Markush grouping,” Applicants respectfully respond that the amended claim 13 recites alternative limitations in a proper *Markush* form. *See* MPEP § 2173.05(h).

Regarding claim 14, Applicants have cancelled this claim, rendering the rejection under Section 112 moot.

### III. Rejections Based on Prior Art

The Office Action rejects claims 1-11 under 35 U.S.C. § 102(b), stating as grounds that each of these claims is anticipated by any of U.S. Patent No. 5,299,610 (“Sentagnes”), U.S. Patent No. 5,299,610 (“Pallmann”) and/or German Patent No. DE-AS 1104676 (“DE ‘676”, (the Office Action misread “Krefeld,” which is a city, as being the applicant of said reference).

Applicants respectfully submit that none of the references relied upon anticipates claim 11, or any of its dependent claims 12-13, or 15-24.

Applicants claim 11, as currently amended, is reproduced below (with deletion lines and underlines removed):

11 (Currently Amended). An apparatus for producing veneer strips or chipped wood, comprising:

a) a chipping tool;

b) a feed means for feeding a plurality of wood groups, each wood group being a stacked arrangement of planar wood pieces, toward said chipping tool, in manner such that plurality of wood groups are fed in a successive manner, along a line, and are spaced closely together, wherein said feed means includes

a conveyor for conveying said plurality of said wood groups in an advancement direction, said advancement direction being a longitudinal direction toward the chipping tool, said conveyor being constructed and arranged to apply an advancement force in the advancement direction to at least one of said wood groups such that a leading group, which is the wood group most proximal to the cutting tool is urged, by at least one of the wood groups succeeding it, with a longitudinal compressive force, said conveyor further including

i) an adjusting means for adjusting said longitudinal compressive force to exceed a cutting force to which the leading group is subjected by the chipping tool, and

ii) a braking means for applying a braking force to said leading group at a location proximal to said cutting tool, said braking means having an adjustment means for adjusting said braking force so as to substantially absorb said longitudinal compressive force by said leading group acting as an abutment.

Sentagnes appears to describe a process and apparatus for continuous chipping of long, round timbers. Sentagnes does not disclose, teach or suggest, explicitly or inherently, any structure that performs the claim 11 “feed means” function of feeding “a plurality of wood groups, each wood group being a stacked arrangement of planar wood pieces.” Logs are not within the broadest reasonable meaning of “wood groups, each wood group being a stacked arrangement of planar wood pieces.” Sentagnes does not disclose, teach or suggest, explicitly or inherently, anything performing function within the broadest reasonable meaning of the claim 1 “braking means,” much any structure for performing that function equivalent to the structures described by Applicants’ specification and drawings. Further, Sentagnes does not disclose, teach or suggest, explicitly or inherently, anything performing a function within the broadest reasonable meaning of the claim 1 “adjustment means,” much less any structure for performing that function equivalent to the structures described by Applicants’ specification and drawings.

Pallmann likewise describes a process and apparatus for continuous chipping of long timbers. Pallmann discloses the timbers being arranged according to length, *see* Pallmann at column 6, lines 12-27. However, that disclosure in Pallmann is not within the broadest reasonable meaning of the claim 11 “feed means ... feeding a plurality of wood groups, each wood group being a stacked arrangement of planar wood pieces.” Pallmann discloses a vertical press, shown as item “17” in Pallmann’s Fig. 1. However, Pallmann discloses nothing as to the press 17 being adjustable, and therefore does not disclose the claim 11 “adjusting means.” There is no basis for asserting that Pallmann’s press 17 is inherently adjustable.

The Office Action does not cite DE ‘676 as a reference disclosing Applicants’ claim 11 braking means, or its adjustment means. For the record, though, Applicants respectfully submit that DE ‘676 discloses none of these claim 11 means.

Applicants respectfully submit that, for the foregoing reasons, none of Sentagnes, Pallmann or DE ‘676 anticipates Applicants’ claim 11, as currently amended, within the meaning of 35 U.S.C. § 102. Therefore, Applicants respectfully request that the rejection be reconsidered and withdrawn.

With respect to dependent claims 12-13 and 15-24, all of these are combination claims having, in addition to their own limitations, all of the limitations of their base claim 1. Therefore, all of these claims are patentable over the cited references for at least the reasons Applicants have shown for claim 11 above.

Further, with respect to dependant claim 12, this claim recites:

wherein said braking means includes said conveyor being constructed and arranged to apply a first advancement force to at least one of said wood groups and a second advancement force to at least one other of said wood groups, said first advancement force having a magnitude different than said second advancement force, wherein the difference in magnitude is such that said leading group acts as a run-on brake by being braked in relation to one or more of its spatially succeeding wood groups.

Claim 12 (currently amended) at lines 2-8

None of Sentagnes, Pallmann and/or DE '676 disclose any structure for applying a first advancement force and second advancement force, in the direction recited by Applicants' claims 11 and 12, having respectively different magnitudes, even to logs much less to "wood groups" as defined in claim 12's base claim 11. Referring to Sentagnes, the only structure it shows for conveying logs (Sentagnes shows nothing that conveys "wood groups" as defined by Applicants' claim 11) to a cutter is the plurality of rollers 18. *See* Sentagnes at Fig. 1. Sentagnes teaches nothing as to different ones of its rollers 18 applying different forces or having different speeds. As to Pallmann, the only structures this reference shows for conveying logs (Pallmann shows nothing that conveys "wood groups" as defined by Applicants' claim 11) to a cutter is the "single common pushing plate 29" which pushes a train of logs into a cutter. *See* Pallmann at column 6, lines 13-27 and at column 8, line 23 through column 9, line 20. Turning to DE '676, the only structure this reference discloses for conveying wood to a cutter is the belt 17 having teeth 8. Since the belt 17 is continuous, all of the teeth exert the same force, at the same speed.

Applicants therefore respectfully request that, for the reasons above that are additional to claim 12 being patentable because of base 11 being patentable, the rejection of dependent claim 12 be reconsidered and withdrawn.

Further, with respect to dependent claim 16, this claim recites:

wherein the conveyor is constructed and arranged to selectively urge at least one of said wood groups at a first advancement speed in the advancement direction and to selectively urge at least one other said wood groups at a second advancement speed in the advancement direction, and wherein the first advancement speed and the second advancement speed are independently selectable.

Claim 16 (currently amended) at lines 2-8

None of Sentagnes, Pallmann and/or DE '676 disclose any structure for urging even a first and second wood groups at a first and second advancement force speed, respectively, in an "advancement direction," *i.e.*, toward the cutter, where the first and second advancement speeds are independently selectable. Sentagnes shows only a plurality of rollers 18, for conveying logs (Sentagnes shows nothing that conveys "wood groups" as defined by Applicants' claim 11). *See* Sentagnes at Fig. 1. Sentagnes teaches nothing as to different ones of its rollers 18 urging their respective log groups at different speeds, and nothing as to the rollers 18 being independently controllable. Pallmann shows only a "pushing plate 29," which cannot, by its very nature, urge different pieces of wood at different speeds. DE '676 shows only a belt 17 having teeth 8. Since the belt 17 is continuous, all of the teeth exert the same force, at the same speed.

Applicants therefore respectfully request that, for the reasons above that are additional to claim 16 being patentable because of base 11 being patentable, the rejection of dependent claim 16 be reconsidered and withdrawn.

With respect to dependent claim 19, the Office Action did not appear to give patentable weight to the angle limitation because "the Examiner took the position that the angle encompassed "0 degrees." Office Action at page 4. Applicants respectively respond that dependent claim 19 has been amended to explicitly not encompass "0 degrees." *See* claim 19 (currently amended) at line 3. Applicants therefore respectfully request that, for the reason above that is additional to claim 19 being patentable because of base 11 being patentable, the rejection of dependent claim 19 be reconsidered and withdrawn.

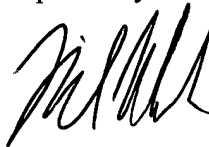
New claims 25-29 are all dependent on claims 7, 8 and 9, which the Office Action indicated as having patentable subject matter.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1-9, 11-13, and 15-29 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: mike@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



Michael E. Whitham  
Reg. No. 32,635

Whitham, Curtis & Christofferson, P.C.  
11491 Sunset Hills Road, Suite 340  
Reston, VA 20190  
703-787-9400  
703-787-7557 (fax)

Customer Number 30743